<u>REMARKS</u>

Status of the Claims

Claims 1-10 are pending with Claims 1, 9 and 10 being independent. Claim 11has been canceled without prejudice to or disclaimer of the subject matter recited therein. Claims 1, 9 and 10 have been amended. Support for the claim changes can be found in the original disclosure, for example, in Figs. 1-10 and the accompanying disclosure, such as at pages 18-22, and therefore no new matter has been added.

Requested Action

Applicant respectfully requests the Examiner to reconsider and withdraw the outstanding rejections in view of the foregoing amendments and the following remarks.

Formal Rejection

Claims 9, 10 and 11 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In response, while not conceding the propriety of the rejection, Claims 9 and 10 have been amended to address the points raised in the Office Action and Claim 11 has been canceled without prejudice. Applicant submits that as amended, these claims now even more clearly satisfy 35 U.S.C. § 101 and submits that the rejection of Claim 11 is moot because Claim 11 has been canceled without prejudice. Therefore, Applicant respectfully requests that the rejection of these claims be withdrawn.

Substantive Claim Rejections

Claims 1, 2 and 6-11were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2002/0122202 (<u>Nagashima</u>) in combination with U.S. Patent No.

6,751,352 (Baharav et al.). Claims 3-5 were rejected under 35 U.S.C. § 103(a) as being

unpatentable over Nagashima in combination with U.S. Patent No. 5,227,893 (Ett).

In response, while not conceding the propriety of the rejections, independent Claims 1, 9

and 10 have been amended. Applicant submits that as amended, these claims are allowable for

the following reasons.

Independent Claim 1 relates to an image processing apparatus comprising a first input

unit configured to input application data created by predetermined application software, a second

input unit configured to input print data, the print data being generated by converting the

application data, a registration unit configured to register both the application data and the print

data generated from the application data in a database with a specific index, wherein the

application data and the print data are associated with each other by the specific index, a

transmitting unit configured to transmit data to an external apparatus, a printing unit configured

to print an image on a sheet based on the print data, a designation unit configured to designate a

data output method, a scanning unit configured to scan a printed material on which a

predetermined code is printed, an index input unit configured to analyze the predetermined code,

which is printed on the printed material, and to input the specific index corresponding to the

analyzed predetermined code, and a control unit.

Claim 1 has been amended to recite that the application data is usable by another image

processing apparatus. Claim 1 has also been amended to recite that the second input is

configured to input print data suitable for printing, and that the designation unit is configured to

designate a transmitting process or a printing process as a data output method.

Claim 1 has also been amended to recite that the control unit is configured to select the

application data for transmission from among the application data and the print data and to

control the transmitting unit to transmit the application data but not the print data, identified using the specific index input by the index input unit, to the other image processing apparatus when the designation unit designates the transmitting process as the data output method, and to select the print data for printing from among the application data and the print data and to control the printing unit to print an image on a sheet based on the print data but not the application data, identified using the specific index, when the designation unit designates the printing process as the data output method.

By this arrangement, the selection of the application data or the print data for outputting can be based on the data output method: if transmission is the designated data output method, the application data is transmitted and the print data is not; if printing is the designated data output method, the print data is printed and the application data is not. As a result, a) faster printing can be achieved when printing is selected, b) the load on the network can be reduced when the transmission process is selected because the application data has a smaller data size than its corresponding print data, which can take the form of image data of a larger size than the application data, and c) the transmitted application data can be easily edited by the apparatus receiving it, unlike its corresponding image data.

In contrast, the citations to Nagashima and Baharav et al. are not understood to teach the concept of basing the selection of either the application data or the print data on the designated data output method, so that if the transmission process is designated as the data output method, the application data is transmitted and the print data is not transmitted, and if the printing process is designated as the data output method, the print data is printed and the application data is not.

As a result, these citations are not understood to disclose or suggest a control unit configured to select the application data for transmission from among the application data and

the print data and to control the transmitting unit to transmit the application data but not the print data, identified using the specific index input by the index input unit, to another image processing apparatus when the designation unit designates the transmitting process as the data output method, and to select the print data for printing from among the application data and the print data and to control the printing unit to print an image on a sheet based on the print data but not the application data, identified using the specific index, when the designation unit designates the printing process as the data output method, as recited by amended Claim 1.

The Nagashima publication appears to identify Registration Files A and B as the claimed application data and print data (page 6, lines 4-6 of the Office Action explains, in discussing the claimed associating of the application data and the print data with each other by a specific index, that the "Registration File ID" and the "Produces Files ID" 1-3 discussed in paragraphs [0056] - [0063] of the Nagashima publication "are the specific index associated with Registration Files A and B".). However, the selection of registration file A or registration file B is not understood to be based on the data output method selected. Moreover, Applicant can find no disclosure in the Nagashima publication of the selecting for transmission to another image processing apparatus and the transmitting of one of file A and file B, identified using a specific index, to another image processing apparatus when transmission is the designated data output method, and the selection for printing of and the printing of an image based on the other of File A and File B, identified using the specific index, when printing is the designated data output method. Further, coversheet templates appear to be registered in both registration files A and B. As a result, it is not seen how one of these files is the claimed application data, while the other file is the claimed print data, since both files appear to be of the same type, and the independent claims recite that the print data is generated by converting the application data.

Since amended Claim 1 recites at least one feature not understood to be disclosed or suggested by the citations to <u>Nagashima</u> and <u>Baharav et al.</u>, Applicant submits that the Office has not yet satisfied its burden of proof to establish a *prima facie* case of obviousness against amended Claim 1. Therefore, Applicant respectfully requests that the rejection of amended Claim 1 be withdrawn. And because corresponding method and medium Claims 9 and 10 have been amended to recite corresponding features, they are submitted to be allowable for corresponding reasons. Therefore, Applicant respectfully requests that the rejection of Claims 9 and 10 be withdrawn.

The dependent claims are also submitted to be patentable, due to their dependency from the independent base claims, as well as due to additional features that are recited. Individual consideration of the dependent claims is respectfully solicited.

Conclusion

In view of the foregoing amendments and remarks, it is respectfully submitted that the pending claims are allowable over the art of record, and that the application is in condition for allowance. Therefore, favorable reconsideration and early passage to issue of the application are earnestly solicited.

The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 06-1205.

Applicant's undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our address given below.

Respectfully submitted,

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